



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,743	02/02/2001	Lioudmila Tchistiakova	082181-36154	9394

26345 7590 06/20/2002

GIBBONS, DEL DEO, DOLAN, GRIFFINGER & VECCHIONE
1 RIVERFRONT PLAZA
NEWARK, NJ 07102-5497

EXAMINER

CHERNYSHEV, OLGA N

ART UNIT PAPER NUMBER

1646

DATE MAILED: 06/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/775,743

Applicant(s)

TCHISTIAKOVA ET AL.

Examiner

Olga N. Chernyshev

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 25-41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 25-26, 32-36 in so far as they are drawn to a pharmaceutical compound comprising amino acid sequence of SEQ ID NO:1, classified in class 530, subclass 326, for example.
 - II. Claims 25, 27, 32-36 in so far as they are drawn to a pharmaceutical compound comprising amino acid sequence of SEQ ID NO:2, classified in class 530, subclass 326, for example.
 - III. Claims 25, 28, 32-36 in so far as they are drawn to a pharmaceutical compound comprising amino acid sequence of SEQ ID NO:3, classified in class 530, subclass 326, for example.
 - IV. Claims 25, 29, 32-36 in so far as they are drawn to a pharmaceutical compound comprising amino acid sequence of SEQ ID NO:4, classified in class 530, subclass 326, for example.
 - V. Claims 25, 30, 32-36 in so far as they are drawn to a pharmaceutical compound comprising amino acid sequence of SEQ ID NO:5, classified in class 530, subclass 326, for example.
 - VI. Claims 25, 31-36 in so far as they are drawn to a pharmaceutical compound comprising amino acid sequence of SEQ ID NO:7, classified in class 530, subclass 326, for example.

- VII. Claim 37, in so far as it is drawn to a method of treating a disease by administering a pharmaceutical compound comprising amino acid sequence of SEQ ID NO:1, classified in class 514, subclass 2, for example.
- VIII. Claim 37, in so far as it is drawn to a method of treating a disease by administering a pharmaceutical compound comprising amino acid sequence of SEQ ID NO:2, classified in class 514, subclass 2, for example.
- IX. Claim 37, in so far as it is drawn to a method of treating a disease by administering a pharmaceutical compound comprising amino acid sequence of SEQ ID NO:3, classified in class 514, subclass 2, for example.
- X. Claim 37, in so far as it is drawn to a method of treating a disease by administering a pharmaceutical compound comprising amino acid sequence of SEQ ID NO:4, classified in class 514, subclass 2, for example.
- XI. Claim 37, in so far as it is drawn to a method of treating a disease by administering a pharmaceutical compound comprising amino acid sequence of SEQ ID NO:5, classified in class 514, subclass 2, for example.
- XII. Claim 37, in so far as it is drawn to a method of treating a disease by administering a pharmaceutical compound comprising amino acid sequence of SEQ ID NO:7, classified in class 514, subclass 2, for example.
- XIII. Claims 38-41, in so far as it is drawn to a nucleic acid molecule encoding a polypeptide of SEQ ID NO:1, vector and a host cell classified in class 435, subclass 69.1, for example.

- XIV. Claims 38-41, in so far as it is drawn to a nucleic acid molecule encoding a polypeptide of SEQ ID NO:2, vector and a host cell classified in class 435, subclass 69.1, for example.
- XV. Claims 38-41, in so far as it is drawn to a nucleic acid molecule encoding a polypeptide of SEQ ID NO:3, vector and a host cell classified in class 435, subclass 69.1, for example.
- XVI. Claims 38-41, in so far as it is drawn to a nucleic acid molecule encoding a polypeptide of SEQ ID NO:4, vector and a host cell classified in class 435, subclass 69.1, for example.
- XVII. Claims 38-41, in so far as it is drawn to a nucleic acid molecule encoding a polypeptide of SEQ ID NO:5, vector and a host cell classified in class 435, subclass 69.1, for example.
- XVIII. Claims 38-41, in so far as it is drawn to a nucleic acid molecule encoding a polypeptide of SEQ ID NO:7, vector and a host cell classified in class 435, subclass 69.1, for example.
- XIX. Claims 38-41, in so far as it is drawn to a nucleic acid molecule encoding a polypeptide of SEQ ID NO:8, vector and a host cell classified in class 435, subclass 69.1, for example.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions I, II, III, IV, V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the

Art Unit: 1646

instant case the different inventions are directed to compounds that have different chemical structure and are not required one for the other and, therefore are patentably distinct.

3. Inventions (I-VI) and (XIII-XIX) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acids of Groups (XIII-XIX) and polypeptides of Groups (I-VI) are distinct inventions because they are physically and functionally distinct chemical entities, and the protein product can be made by another and materially different process, such as by synthetic peptide synthesis or purification from the natural source. Further, the DNA may be used for the processes other than the production of the protein, such as nucleic acid hybridization assay.

4. Inventions (VII-XII) and (XIII-XIX) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not required one for the other in that the DNA of Groups (XIII-XIX) are not required for the methods of Groups (VII-XII).

5. Inventions XIII, XIV, XV, XVI, XVII, XVIII and XIX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to compounds that have

Art Unit: 1646

different chemical structure and are not required one for the other and, therefore are patentably distinct.

6. Inventions VII, VIII, IX, XI and XII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to methods involving using compounds that have different chemical structure and are not required one for the other and, therefore are patentably distinct.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter and non-coextensive literature searches, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1646

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (703) 305-1003. The examiner can normally be reached on Monday to Friday 9 AM to 5 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (703) 308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 782-9306 for regular communications and (703) 782-9307 for After Final communications.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 308-4556 or (703) 308-4242. If either of these numbers is out of service, please call the Group receptionist for an alternative number. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Application/Control Number: 09/775,743


Art Unit: 1646

Page 8

Olga N. Chernyshev, Ph.D.

June 12, 2002

OC


JOHN ULM
PRIMARY EXAMINER
GROUP 1800